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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,097	11/27/2001	Nick (Nicholas Sheppard) Bromer		9382

7590 07/02/2003

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EXAMINER
KLEBE, GERALD B

ART UNIT	PAPER NUMBER
3618	

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/995,097	Bromer
Examiner	**Art Unit**
Gerald Klebe	3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 19, 2003*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *2-17* is/are pending in the application.

4a) Of the above, claim(s) *4, 7, and 10* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *2, 3, 5, 6, 8, 9, and 11-17* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

GKlebe
20 June 2003

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Prosecution Reopened

1. In view of the appeal brief filed on 3/31/2003, and the Decision on Petition, mailed May 27, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

NOTE: The Finality of the previous Office action (Paper No. 8) is withdrawn in view of the following. An action on the merits follows.

Amendment(s)

2. The amendment filed 9/25/2002 under 37 CFR 1.111 has been entered (Paper No. 9). By this amendment the specification was amended in the paragraph starting at page 10, line 15, and claim 17 was amended to remove the rejection under 35 U.S.C. 112, Second Paragraph made in the Office action mailed 9/16/2002 (Paper No. 8). Claims 2-17 are pending in the application, of

which claims 4, 7, and 10, being drawn to a non-elected species, stand withdrawn from further consideration.

Drawings

3. A "return spring" (claim 12) is not shown in the elected embodiment of Figure 1, as is required.

Oath/Declaration

4. The Oath/Declaration filed 11/27/2001 is defective. It has not been dated and the post office address of the applicant is not provided; and it does not identify the application being attested to.

Although Applicant stated in his remarks that a new declaration with the requested additional information was submitted, none has been received. A new Oath/Declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP Sections 602.01 and 602.02.

Specification -- Objections

5. The specification, including the drawings, is objected to as it relates to connection and operation of elements of the skate and brake mechanism, particularly regarding the disclosure of Figure 1.

Figure 1 shows the pivot arm structure 100 being pivotally hinged on pin 130 (which is coaxial with the axle of the second wheel W2 of the skate) and extending forwardly and upwardly (arm 120) to the toe-cap lifter 110, and forwardly and downwardly from the hinge pin (as arm

extension 140 which terminates in the brake shoe 150). The structure 100 appears to be a planar structure pivoted on the axis 130 and no further details of the structure are provided in the specification to modify this interpretation of the structure as being planar. A number of "enablement" problems appear to be present, therefore, in the disclosure: 1) as shown, the structure would appear to have the brake shoe 150 engage the side of the wheel W1 rather than its tread since the extension arm 140 appears to lie transversely the outside plane of both wheels (the second wheel W2 whose axle it is pivotally attached to, and the front wheel to be braked, W1); 2) the wheel truck structure (T) for known in-line skates would be expected to occupy the position shown occupied by the pivot arm lift structure 100, and so mechanical interference between the truck and the pivot arm would exist; and 3) the pivot arm lift structure 110 is shown to be outside the lateral edge of the skate plate (unnumbered in the Figures shown) to which the boot is affixed, such that it is not clear how the brake shoe could engage the surface of the wheel that in known in-line skates would be underneath on the centerline of the skate plate.

Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2-3, 5-6, 8-9, and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 2 recites limitations of a skate braking mechanism wherein a lifter is connected to a brake and is pressable upward by the toe of the user to actuate the brake; independent claim 8 recites limitations of a skate brake and a brake shoe coupled to the lifter and wherein the brake shoe is pivoted to rotate about an axle of another wheel to bear on at least one wheel of the skate brake when actuated; and independent claim 16 recites limitations of a skate braking mechanism comprising a brake and means for actuating the brake by pressing upward the toe of the user.

These recitations are not enabled by the disclosure, including the drawings, since it appears that there would be mechanical interference among the structures of the brake mechanism and the wheel frame of the skate as disclosed that would prevent the pivotal motion of the braking structure, and to enable the brake shoe to fit between the adjacent wheels of a conventional in-line skate in order to engage the wheel to be braked.

Appropriate correction or clarification is required. No new matter may be entered.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2, 3, 12, and 16, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Intengan (US 6053511).

Intengan discloses, for a user having a toe and standing on a skate, a skate braking mechanism comprising:(**re: claims 2 and 16**) a brake (55) and a lifter (combination of 42, 46, 47, 48, 49 54, 56) connected to the brake and pressable upward by the toe of the user to actuate the brake (refer to Fig 3A), whereby the brake is actuated according to a natural motion of the user to maintain balance (refer col 2, lines 31-37); and further (**re: claim 3**) wherein the lifter is pivoted (about the pivots 54 and 47-48) to be moved upward by the toe; and further (**re: claim 12**) comprising a return spring (53) counteracting an upward pressing motion of the toe.

10. Claim 16, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Carlsmith (US 5232231).

Carlsmith discloses (Fig 2) a skate braking mechanism for a user having a toe and standing on a skate, wherein the braking mechanism comprises a brake (the ground engaging device shown depending from the rear of the skate) and means for actuating the brake by pressing upward the toe of the user (as shown in Fig 2, the user presses upward the toes of the foot in the skate to be braked, thereby elevating the front of the skate upwardly and thereby bringing the brake into contact with the ground).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Intengan (US 6053511) in view of Hoskin (US 5183275).

a. Intengan discloses, for a user having a toe and standing on a skate having at least one wheel, a skate brake actuated by dorsiflexion as broadly claimed, comprising: a lifter moved upward by the dorsiflexion to actuate the brake; and comprising a brake shoe coupled to the lifter.

b. When actuated, Intengan's brake shoe bears upon the ground supporting surface of the skate rather than on the at least one wheel of the skate.

c. However, Hoskin teaches a ground engaging brake shoe for an in-line roller skate that includes a movable roller for selective engagement with a wheel of the skate when the brake shoe is actuated to bear upon the ground.

d. Therefor, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the brake shoe of Intengan to include a roller pad arrangement to bear upon the wheel of the skate in accordance with the teachings of Hoskin in order to further distribute the braking forces of the brake pad over an enlarged surface area to reduce the wear rate of the brake shoe as suggested by the reference at column 2, line 64 to column 3, line 3.

e. Regarding the further limitation of the claim wherein the brake shoe is pivoted to rotate about an axle of another wheel, the combination of Intengan and Hoskin as discussed above pivots the lifter of the brake shoe about a transverse axis mounted on the skate's wheel frame. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have relocated the pivot axis of the lifter to be an axle of another wheel of the skate, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Argument

13. Applicant's arguments regarding rejections based upon 35 USC 112, first paragraph (enablement); Applicant's arguments have been fully considered but are unpersuasive in removing the rejections.

Regarding the examiner's statement the structure 100 appears to be planar, Applicant refers to shading lines on Figure 1 and the specification at page 8, line 19, reading "The second arm extension widens to meet the edges of the toe-cap lifter 110." and the passage at page 8, line 6 stating that the brake shoe can be curved in the transverse direction (which continues, in explanation, "the surface [of the shoe] facing the wheel is somewhat toroidal". It is not clear what this means as a response to the examiner's assertion that the structure appears to be planar. A toroid is understood in analogous terms to be a donut-shape; the brake shoe does not appear to be donut-shaped to the examiner.

The reference to " line shadings" and accompanying discussion as to their meaningfulness to enabling the disclosure are not considered sufficient to make the disclosure as filed enabling to one skilled in the art, since these line shadings and text could be interpreted in various ways not enabling one skilled in the art to build Applicant's's invention without significant experimentation to realize a working embodiment of the skate brake conception of the Applicant.

- Regarding Applicant's invocation of an affidavit stating that the model demonstrated at the interview of May 15, 2002 was built before the filing of the application and that the model demonstrates that the Applicant contemplated at the time of filing braking against the tread of a wheel; a non-planar design; and hinge support on both sides of the arm, Applicant's argument is off the mark, since it is not the model, but the disclosure as originally filed that is subject to the rejection under 35 U.S.C. 112, first paragraph as being non-enabling.

-Relative to the rejection of claims using the reference due to Intengan, Applicant argues that the reference states that the foot is made to"arch" with the toes pressed downward and that this is opposite to the claimed toe motion. The examiner points out that the language of the claim is interpreted broadly as found in Applicant's disclosure as any movement of the toes and foot that causes to press upward the brake lifter mechanism. (Refer to the specification page 12, lines 9-21 which states: "The invention contemplates brake activation by any lifting action of the front portion of the foot, in addition to dorsiflexion of the toes per se. For example, a brake actuator can be lifted by the metatarsals to apply braking force, and the invention includes a lifter farther back than the toes, for example over the metatarsal, to provide the same advantages as are

provide by brake activation by dorsiflexion of the toes without upward motion of the metatarsal. A downward motion of the phalanges relative to the metatarsal, that helped to arch the foot and raise the metatarsal, would be "dorsiflexion" within the meaning of the following claims if the resulting motion of a brake actuator were upward.") Applicant's arguments rely on structure not contained in the claim recitations. Applicant misinterprets the principle that claims are interpreted in the light of the specification. Nor are the words used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

Regarding Applicant's request for a showing that urethane and fiber-reinforced elastomers are materials old and well-known in the skate arts, the Applicant is referred to the reference to Carlsmith cited in the previous Office action for use of urethane and fiber reinforced polymers in the manufacture of in-line skates (refer to column 7, lines 46-49, and column 9, lines 22-26).

Regarding Applicant's further arguments, these have been fully considered but are moot in light of the new grounds of rejection.

Action made Final

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Prior Art made of Record

15. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure; the prior art of Donovan et al. uses the word dorsiflexion as meaning a movement of the foot from a neutral position towards the leg involving movement about the ankle joint.

Conclusion

16. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe, at 703-305-0578; fax 703-308-2571; Mon.-Fri. 8:00 AM-4:30 PM ET; or, to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

gbKlebe / Art Unit 3618 / 23 June 2003

BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
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6/24/03